UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,799	01/10/2002	Erwin Roy John	50124/00303	5663

30636 7590 05/04/2005

FAY KAPLUN & MARCIN, LLP
150 BROADWAY, SUITE 702
NEW YORK, NY 10038

EXAMINER	
NASSER, ROBERT L	
ART UNIT	PAPER NUMBER
3736	

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/045,799	JOHN ET AL.	
	Examiner	Art Unit	
	Robert L. Nasser	3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *45-55, 59, 65, 66, 68* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *45-55,59,65,66 and 68* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 45-47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6385486. Although the conflicting claims are not identical, they are not patentably distinct from each other because the current claims are broader versions of the patented claims, and, as such, are covered by the patented claims.

Claim 55 is objected to because of the following informalities: Claim 55 is objected to in that there is no antecedent basis for the transmitter means as it was previously referred to in claim 52 as a radio transmitter. The claim further fails to make sense, since in the base claim, it recites a radio transmitter and this claim recites a radio transmitter or a cellular phone.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 52, 54, 55, and 65 are rejected under 35 U.S.C. 102(b) s being anticipated by DeVito 6001005. De Vito shows a system with a headband 20 having EEG electrodes 23, 24, 25 thereon, an amplifier 31 mounted on the headband, a radio transmitter 35 on the headband for broadcasting signals to a receiver 41, and an output device 53 that outputs a signal based on the broadcast signal. Claim 54 is rejected in that the headband is a "patch" and the electrodes 23, 24, and 25 include a positive and negative electrode. In addition, it is inherent that there is a ground.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 48-50, 59, and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee 4454886 in view of in view of Zimmerman et al 5279305 and Devito. Lee shows a device with an active electrode 14 producing EEG signals, a filter 18 producing signals in a predetermined frequency range (1-60hz), and a tone generator producing an audio output, generally music, corresponding to the signal. It does not have the connection means or the telemetry signal. Zimmerman et al teaches that it is desirable to have the electrode arrangement wirelessly communicate with the processor to allow the user freedom of movement during measurement. Hence, it would have been obvious to modify Lee to use wireless communication, so as to allow the patient to move around. In addition, DeVito shows a wireless EEG headband

device that includes an amplifier mounted on the headband. It would have been obvious to modify the above combination to use such a headband, as it is merely the substitution of one known equivalent EEG electrode device for another.

Claims 48-50, 59, and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross et al 4800803 in view of Zimmerman et al 5279305 and Devito. Ross et al shows a device with an active electrode 1a, 1b, 1c producing EEG signals, a filter 28 producing signals in a desired, predetermined frequency range, and a tone generator 23 producing an audio output, music, corresponding to the EEG signal. It does not have the connection means or the telemetry signal. Zimmerman et al teaches that it is desirable to have the electrode arrangement wirelessly communicate with the processor to allow the user freedom of movement during measurement. Hence, it would have been obvious to modify Lee to use wireless communication, so as to allow the patient to move around. In addition, DeVito shows a wireless EEG headband device that includes an amplifier mounted on the headband. It would have been obvious to modify the above combination to use such a headband, as it is merely the substitution of one known equivalent EEG electrode device for another.

Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ross et al 4800803 in view of Zimmerman et al 5279305 and Devito, as applied to claims 48-50, 59, and 68 above, further in view of Yashushi et al 5241967. Yashushi further teaches that a desired level for inducing a particular brain state is one of alpha, theta, delta and beta brain wave states. Hence, it would have been obvious to modify the

above combination to filter at one of these bands, as they are well known bands used to produce the desired brain wave state.

Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roy et al 3696808 in view of DeVito. Roy shows an EEG monitoring system that provides an output signal indicating that a brain injury is detected. It is not an audible or a light signal. However, the examiner takes official notice that it is well known to provide such a display signal, using an LD (lights). In addition, De Vito shows an EEG monitoring circuit that meets the remainder of the claim features, as discussed above. Hence, it would have been obvious to modify Roy to use the circuit of De Vito, as it is merely the substitution of one known EEG monitoring circuit for another.

Claim 66 is rejected under 35 U.S.C. 103(a) as being unpatentable over De Vitc. Applicant has not stated that the specific number of electrode sand amplifiers is for a specific purpose or that they solve a stated problem. As such, it appears that the exact number of electrodes and amplifiers would have been a mere matter of design choice for one skilled in the art.

Applicant's arguments filed 1/26/2004 have been fully considered but they are deemed moot in view of the new grounds of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert L. Nasser whose telephone number is (571) 272-4731. The examiner can normally be reached on Mon-Fri, variable hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert L. Nasser
Primary Examiner
Art Unit 3736

RLN
May 1, 2005

ROBERT L. NASSER
PRIMARY EXAMINER